

### **REMARKS**

In the Office Action, the Examiner rejected all pending claims (indicating that claims 83-88 were withdrawn). By this Response, Applicant amends claims 1, 16, 31, 34, 51, 70, and 79. These amendments do not add any new matter. Support for the amendments may be found at least in paragraph 15 and FIG. 1 of the instant specification. Applicant respectfully requests reconsideration and allowance of all claims in view of the foregoing amendments and the following remarks.

### **Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-9 and 14-26 under 35 U.S.C. § 102(e) as being anticipated by Knox et al. (U.S. Patent Application Publication No. 2004/0252421, hereinafter “Knox”). The Examiner further rejected claims 1, 16, 31, 34, 51, and 79 under 35 U.S.C. § 102(b) as anticipated by Brown et al. (U.S. Patent No. 6,388,563, hereinafter “Brown”). Applicant respectfully traverses these rejections.

Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under 35 U.S.C. § 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

**Rejection of claims 1-9 and 14-26 as anticipated by Knox**

In rejecting claims 1-9 and 14-26, with respect to the independent claims the Examiner specifically stated:

With respect to Claim 1, Knox discloses a controller for a machine, comprising: a machine mountable base [Fig. 3, the base comprises stacked modules- DSP housing 46, transformer housing 44, and housing base 41; par. 0020, the modular base housing portion] comprising a motor protection device housed in the base [Fig. 3 the Digital Signal Processor DSP 55 in housing 46; par. 0008] and a network terminal [Fig. 1, RS 485 communications 8; par. 01 47 lines 8-11; par 0027. Note: interpreted in view of applicant's spec at par. 0013 and 0015] configured to connect the base to a central or remote system via a power and data distribution structure; and a modular control unit [Fig. 5 modular control unit 2 containing microcontroller 75; par. 0104] replaceably mountable to the machine mountable base [par. 0030; all components are mounted to housing base 41 and are modularized/replaceable], wherein the modular control unit comprises control circuitry [modular control unit 2 contains microcontroller 75] configured to control the machine [the circuitry of microcomputer 75 allows the user to enter control commands and receive status updates of the motor being controlled- par. 0104-0109. The machine being controlled is the low voltage motor mentioned in paragraph 0002] and a machine connection terminal [Fig. 1, terminal blocks 10, 11; par. 0085] configured to enable the modular control unit to couple directly with the machine [terminal blocks 10, 11 is wired to the user's motor/machine].

With respect to Claim 16, Knox discloses a motor controller [Fig. 1 digital programmable motor overload protector 1], comprising: a motor mountable base [Fig. 3, the base comprises stacked modules- DSP housing 46, transformer housing 44, and housing base 41; par. 0020, the modular base housing portion] comprising a shortcircuit tripping disconnect [Fig. 4 trip contact relay 66 is a short circuit protective device that works in conjunction with the DSP 551; and a replaceable control unit [Fig. 5 modular control unit 2 containing microcontroller 75; par. 01 04; the

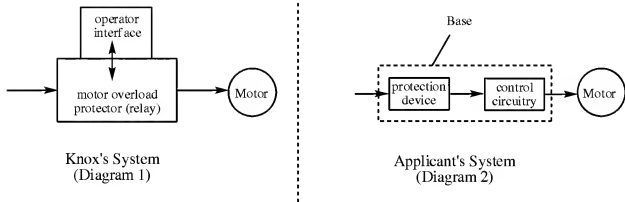
module is replaceable] removably coupled to the motor mountable base, wherein the replaceable control unit comprises control circuitry [modular control unit 2 contains microcontroller 751 configured to control a motor [the circuitry of microcomputer 75 allows the user to enter commands and receive status updates of the motor being controlled- par. 01 04- 01 09. The machine configured to be controlled is any of the low voltage motors mentioned in paragraph 0002] and a motor connection terminal [Fig. 1, terminal blocks 10, 11; par. 0085] configured to enable the modular control unit to couple directly with the motor [terminal blocks 10, 11 is wired to the user's motor machine].

Office Action, pp. 3-6 (emphasis in original).

As amended, independent claim 1 recites, *inter alia*, “a modular control unit replaceably mountable to the machine mountable base, wherein the modular control unit is coupled electrically downstream of the motor protection device and comprises control circuitry configured to be coupled electrically upstream of a motor of the machine and control the motor in operation.” As amended, independent claim 16 recites, *inter alia*, “a replaceable control unit removably coupled to the motor mountable base, wherein the replaceable control unit is coupled electrically downstream of the short circuit tripping disconnect and comprises control circuitry configured to be coupled electrically upstream of a motor and control the motor in operation.”

Inasmuch as the Examiner alleged that Knox discloses that the operator interface 2 comprises control circuitry configured to control the machine, Applicant notes that independent claims 1 and 16 have been amended to recite the general electrical configuration of Applicant's controller. For example, claims 1 and 16 generally recite, *inter alia*, that the control unit is coupled electrically downstream of the protection device (short-circuit tripping disconnect in claim 16), and that control circuitry is configured to be coupled electrically upstream of a motor and control the motor in operation. In stark contrast to these features, Knox describes a system where an operator interface 2 is mounted on a motor protector 1, which is also described as a

relay. See Knox, ¶ [0086]. As its name implies, the relay is controlled by the operator interface, however, and the operator interface does not control the motor. On the other hand, Applicant's control circuitry is recited as being disposed between the protection device and the motor, and controls the motor. Such differences in the electrical configurations of the systems are clearly shown in the diagrams below. Arrows denote electrical power or signal flow.



As should be apparent from reviewing the above diagrams, the electrical configurations of Knox and Applicant are quite different. To be sure, Knox is completely silent with regard to control circuitry being electrically downstream of a protection device. As described by Knox and illustrated in Diagram 1 above, the system of Knox is configured to allow the user interface to send information for regulating operation of the relay, and not the motor. This is clearly not equivalent to the claimed control circuitry that is disposed electrically downstream of a protection device and that controls the motor. As such, Applicant asserts that Knox clearly fails to anticipate claims 1, 16, and the claims depending therefrom.

More specifically, the Examiner asserted that the micro-controller 75 in the modular control unit 2 constitutes control circuitry configured to control the machine. Office Action, page 3. Specifically, the Examiner stated that “the circuitry of microcomputer 75 allows the user to enter control commands and receive status updates of the motor being controlled- par. 0104-0109.” *Id.* This assessment of the Knox reference is erroneous. In the very passage cited by the Examiner, the

Knox reference discloses that the micro-controller 75 controls the user interface 2, not a motor. *See* Knox, ¶ [0104]. Indeed, Knox is directed to “a digital programmable motor overload protector, which provides low noise, low distortion, and high accuracy data acquisition for low voltage motors.” Knox, ¶ [0002]. The user interface 2 enables a user to view the status of the motor and the overload relay. *See* Knox, ¶ [0108]. A digital signal processor (DSP) 55 in the MOP 1 controls the MOP’s operations. *See* Knox, ¶ [0101]. The user interface 2 merely provides an interface with the DSP 55 and does not control the motor in operation. *See* Knox, ¶¶ [0220]-[0234]. Specifically, the micro-controller 75 in the user interface 2 operates to initiate the user interface 2, at which time control of the user interface 2 is taken over by the DSP 55. *See* Knox, ¶¶ [0220] and [0231]. To reiterate, a user interface does not constitute a control unit for controlling a motor in operation as recited in the present claims.

For at least these reasons, the Knox reference does not anticipate independent claims 1 and 16, or their dependent claims. Applicant therefore respectfully requests removal of the rejections of independent claims 1, 16, and their dependent claims, under 35 U.S.C. § 102 as these claims are clearly not anticipated by Knox.

**Rejection of claims 1, 16, 31, 34, 51, and 79 as anticipated by Brown**

In rejecting claims 1, 16, 31, 34, 51, and 79, the Examiner specifically stated:

With respect to Claims 1, 16 and 51, Brown discloses a machine, comprising: a motor [col. 1 lines 17-25]; and a motor controller [Fig. 1, 100; col. 1 lines 46-52], comprising: a modular base [Fig. 1, 300] comprising motor protection circuitry [col. 9 lines 3-14]; such as a short circuit tripping disconnect [col. 10 lines 15-23] which is mounted in the base; and a modular motor control unit [Fig. 1, 200] coupled to the modular base [col. 2 lines 24-45] and comprising motor control circuitry [col. 3 lines 36-44] cooperatively operable with the motor protection circuitry, wherein the modular motor control unit is selectively replaceable from a plurality of different types of motor control units [col. 7 lines 55-62; col. 8 lines 8-12; col. 8 lines 21-31], and a motor/machine connection terminal

[Fig. 2, via 302; col. 3 lines 25-28] configured to enable the modular control unit to couple directly [interpreted as coupled, with potentially intervening components] with the machine.

With respect to claims 31 and 34, Brown discloses a controller for a machine system [col. 3 lines 5-15], comprising: an on-machine base [Fig. 1, 300] comprising a machine protection device [Fig. 1, 200]; and a control unit [Fig. 6, the master control emergency stop module 100; col. 7 lines 60-62, see col. 7 lines 15-63] comprising control circuitry [col. 9 lines 3-14; col. 9 lines 66-67 and col. 10 lines 1-11] configured to directly control [all modes of coupling are anticipated, col. 7 lines 15-31] at least one machine in the machine system, wherein the control unit is selectable from a plurality of different types of control units having different types of control circuitry [col. 7 lines 55-62; col. 8 lines 8-12; col. 8 lines 21-31], the control unit is replaceably mountable to the on-machine base, and the on-machine base and the control unit are cooperative to provide desired on-machine controllability.

With respect to claim 79, see the combined comments for claims 1, 16, 31, 34, and 51 under Brown above.

Office Action, pp. 8-9 (emphasis in original).

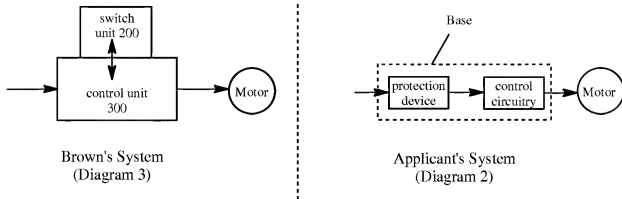
As amended, independent claim 1 recites, *inter alia*, “a modular control unit replaceably mountable to the machine mountable base, wherein the modular control unit is coupled electrically downstream of the motor protection device and comprises control circuitry configured to be coupled electrically upstream of a motor of the machine and control the motor in operation.” As amended, independent claim 16 recites, *inter alia*, “a replaceable control unit removably coupled to the motor mountable base, wherein the replaceable control unit is coupled electrically downstream of the short circuit tripping disconnect and comprises control circuitry configured to be coupled electrically upstream of a motor and control the motor in operation.” Independent claim 31, as amended recites, *inter alia*, “a control unit coupled electrically downstream of the machine protection device and comprising control circuitry configured to be coupled electrically upstream of a motor of at least one machine in the machine system and

control the motor in operation...". Independent claim 34, as amended recites, *inter alia*, "a modular control unit coupled electrically downstream of the short-circuit protective device and replaceably mountable to the machine mountable base, wherein the modular control unit comprises control circuitry configured to be coupled electrically upstream of a motor of at least one machine in the system of distributed machines and control the motor in operation." As amended, independent claim 51 recites, *inter alia*, "a modular control unit coupled electrically downstream of the short-circuit protective device ... wherein the modular control unit comprises control circuitry configured to be coupled to a motor of at least one machine in the system of distributed machines and control the motor in operation." Independent claim 79, as amended, recites, *inter alia* "the modular control unit being disposed electrically downstream of the motor protection circuitry...".

Generally, presently amended independent claims 1, 16, 31, 34, 51, and 79 recite various combinations of a base having a motor protection device and a control unit replaceably mountable to the base having motor/machine control operability, the control unit being disposed electrically downstream of a motor protection device/circuitry. In stark contrast, the Brown reference does not disclose at least these elements.

The Examiner asserted, with respect to claims 1, 16, and 51, that Brown allegedly discloses a motor controller 100 comprising a modular base 300 comprising motor *protection* circuitry and a modular *motor control* unit 200. Applicant respectfully disagrees. Essentially, the emergency stop device 100 of Brown includes a switch unit 200 mounted to a control unit 300. The control unit 300 is coupled to a machine and controls the power source for the machine. *See* Brown, col. 4, lines 42-44 and 61-62. The modular switch unit 200, which is coupled to the machine-mounted control unit 300, switches from a normal state to an emergency state when necessary. *See* Brown, col. 3, lines 18-21. Upon the switch unit 200 switching to the emergency state, the control unit 300 controls the machine's power source. *See* Brown, col. 3, lines 24-29. Inasmuch as the Examiner asserted that the modular switch unit 200 is a modular motor control unit (with which Applicant does not agree), Applicant stresses that the modular

switch unit 200 is not electrically downstream of a motor protection device/circuitry, and *does not control the motor in operation*. The differences of the systems in question are shown in the diagrams below. Arrows denote electrical power or signal flow.



As may be appreciated from the contrasting diagrams above, the systems of Brown and Applicant are quite different. Applicant does not agree with the Examiner that the switch unit 200 is equivalent to a modular motor control unit. However, assuming, *arguendo*, that switch unit 200 may display some indirect form of control, Applicant stresses that this feature would still fail to anticipate the present claims, as the switch unit 200 is not electrically downstream of the control unit 300.

With respect to claims 31 and 34, the Examiner asserted that Brown allegedly discloses a machine system comprising an on-machine base 300 comprising a machine protection device 200, and a control unit 100, which are illustrated in Fig. 1 of Brown. The Examiner further asserted that the alleged control unit 100 is replaceably mountable to the alleged on-machine base 300. Applicant finds such an assertion to be clearly erroneous, as the Examiner has essentially indicated that the alleged control unit 100, which comprises the alleged on-machine base 300 and the alleged machine protection device 200, may be replaceably mountable to one of its own parts (unit 300). To be sure, Brown specifically discloses that the emergency stop device 100 includes the switch unit 200 and the control unit 300:



The emergency stop device 100 comprises a switch unit 200 and a control unit 300 which can be selectively coupled together in a modular manner.

Brown, col. 3, ll. 16-18 (emphasis added).

Thus, according to Brown, the device 100 comprises unit 200 and unit 300. Applicant stresses that device 100 cannot possibly be replaceably mountable to unit 300 as the Examiner alleged, as unit 300 is part of the device 100.

The Examiner cited the combined comments for claims 1, 16, 31, 34, and 51 in the rejection of claim 79. Office Action, p. 9. Applicant finds this statement conflicting in view of the contrasting statements with regard to the unit 200 of Brown. The Examiner alleged unit 200 to be a control unit in the rejection of claims 1, 16, and 51, and alleged the same to be a motor protection device in the rejection of claims 31 and 34. However, Applicant asserts that it is clear on its face that the motor protection device/circuitry is not the same feature as the motor control unit in the present claims. As such, Applicant stresses that the Examiner has failed to show a *prima facie* case of anticipation with regard to claim 79 in light of the deficiencies of Brown and the contradictory statements in the Office Action.

For at least these reasons, Brown does not anticipate independent claims 1, 16, 31, 34, 51, or 79. Applicant therefore respectfully requests removal of the rejections of independent claims 1, 16, 31, 34, 51, and 79 under 35 U.S.C. § 102 as these claims are clearly not anticipated by Brown.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 10-11 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Hollenbeck (U.S. Patent No. 5,557,182, hereinafter "Hollenbeck"). The Examiner rejected claims 10-11, 22-23, 29 and 57-58 as being unpatentable over Haudry et al. (U.S. Patent No. 6,879,230, hereinafter "Haudry") in view of Hollenbeck. The Examiner further rejected claims 1, 2-9, 14-16, 17-21, 24-26, 28-32, 34, 51-53, 56, 59, 60-65, 67,

70, 72-73 and 76-79 as being unpatentable over Haudry. The Examiner rejected claims 80-82 as being unpatentable over Haudry in view of Knox. Applicant respectfully traverses these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes all of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “‘well within the ordinary skill of the art’” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q.

349 (CCPA 1959); *see* M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

**Rejection of claims 10-11, and 22-23 as unpatentable over Knox in view of Hollenbeck**

The Examiner asserted that Knox discloses the recitations of independent claims 1 and 16, but fails to disclose a soft start machine controller. The Examiner asserted that this deficiency is overcome by the hypothetical combination of Knox and Hollenbeck.

On a preliminary note, Applicant respectfully submits that the present claims are allowable at least based on their dependency from allowable base claims. Claims 10 and 11 depend from claim 1, claims 22 and 23 depend from claim 16. Knox fails to disclose all of the elements of independent claims 1 and 16 as set forth above, and Hollenbeck fails to remedy the deficiencies of Knox with respect to these independent claims. Accordingly, Applicant respectfully requests removal of the rejections of dependent claims 10, 11, 22, and 23 under 35 U.S.C. § 103 as these claims are clearly not obvious over Knox in view of Hollenbeck.

In addition, the cited references teach contrastingly different intended purposes and principles of operation, which would change if the cited references were hypothetically combined as suggested by the Examiner. As summarized above, a proposed modification or combination of references is entirely improper and insufficient to support a *prima facie* case of obviousness where the proposed modification or combination would change the principle of operation of the cited reference or render the cited reference unsatisfactory for its intended purpose.

Knox discloses a motor overload protector having a removable user interface module. The principal of operation of Knox requires that the removable module be a user interface. In contrast, Hollenbeck discloses “a controller providing a desired operating area for a motor driving a fan for

inducing a draft in an exhaust.” Hollenbeck, column 1, lines 26-28. The principal of operation of Hollenbeck requires that the controller runs a motor.

The Examiner stated that “Knox’s programmable device is implicitly capable of controlling/protecting any motor in general [par. 0002; par. 0010], including a “a variable frequency machine drive.” Office Action, page 10. The Examiner seems to be confusing elements of the present claims in making this combination. Claims 10, 11, 22, and 23 are not directed to the type of motor being controlled, but rather are further limitations on the controllers in the respective independent claims.

Turning to the claims, claims 10 and 11 generally recite that the modular control unit of claim 1 is a soft start machine controller or a variable frequency machine drive, respectively. Claims 22 and 23 generally recite that the replaceable control unit is a soft start motor controller or a variable frequency machine drive, respectively.

As such, a hypothetical combination of the alleged overload controller in Knox with the alternative controllers the Examiner asserted are disclosed in Hollenbeck would render the alleged overload controller inoperable for its intended purpose. Replacing the user interface module of Knox with a soft start machine controller or variable frequency machine drive would defeat all of the overload notification and monitoring features of Knox. In view of these incompatible principles of operation, the cited references cannot be combined and the Examiner’s rejection is improper. For at least these reasons, among others, Applicant respectfully requests withdrawal of the foregoing combination and the corresponding rejections under 35 U.S.C. § 103.

**Rejection of claims 1, 2-9, 14-16, 17-21, 24-26, 28-32, 34, 51-53, 56, 59, 60-65, 67, 70, 72-73, and 76-79 as unpatentable over Haudry**

Of the claims rejected as obvious over Haudry, claims 1, 16, 31, 34, 51, and 79 are independent. Elements of the claims omitted from Haudry are discussed below. Similar claim elements found in multiple claims will be addressed together.

In rejecting the independent claims 1, 16, and 51 the Examiner asserted that Haudry allegedly discloses a machine, comprising: a motor; and a motor controller, comprising a modular base [Fig. 1, housing 1] comprising motor protection circuitry [Fig. 1, 14, 16, 18] which is mounted in the base; and a modular control unit [Fig. 1; comprising 2 and 3] coupled to the modular base and comprising motor control circuitry, but fails to disclose that the modular base is mounted on a motor. The Examiner further asserted that this deficiency of Haudry is remedied by what is conventionally known in the art, and that a person of ordinary skill in the art would mount the housing 1 of Haudry to a motor for the well-known benefit of accomplishing local, onsite control/protection of the motor.

Applicant respectfully reminds the Examiner that all claim features must be taught or suggested to support a *prima facie* case of obviousness. Haudry does not disclose or suggest a modular motor/machine control unit replaceably mountable to a motor/machine protection base. As with Knox and Brown, Haudry does not disclose a motor protection base and a modular machine control unit coupled to the base as generally recited in the present independent claims.

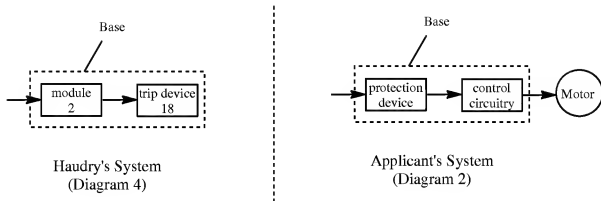
Further, *Haudry fails to disclose a control unit that is electrically downstream of a motor protection device/circuitry* as the present amendments recite. The Examiner alleged that Haudry discloses a modular control unit consistent with the present claims, wherein the control unit comprises protection and control module 2 and communication module 3. Assuming, *arguendo*, that modules 2 and 3 do perform some form of control, these features would still fail to anticipate the present claims, as modules 2 and 3 are electrically upstream of the elements which the Examiner has relied upon as being equivalent to a protection device/circuitry. For example, Haudry explicitly states that module 2 is electrically upstream of the alleged motor protection circuitry (device 18):

The protection module 2 performs a protection function and outputs a fault signal to the trip device 18 when a fault (short

circuit) current is detected by the said sensor, the trip device 18 then controlling opening of the contacts 12.

Haudry, col. 2, ll. 46-50 (emphasis added).

Thus, it is noted, based on Haudry's disclosure, that the protection module 2 is electrically upstream of the trip device 18, and therefore fails to disclose features that are consistent with the present claims. One such difference between Haudry's system and that of Applicant is illustrated in the figure below. Arrows denote electrical flow.



Thus, inasmuch as the Examiner alleged that module 2 is part of a motor control unit and trip device 18 is part of motor protection circuitry, Haudry would clearly disclose a system wherein the motor control unit is electrically upstream of the motor protection circuitry. Further illustrated in the diagrams above, motor/machine control by the control circuitry is not disclosed in Haudry. *Haudry fails to disclose control circuitry that is configured to control a motor of a machine in operation as the presently amended claims recite.*

Applicant notes that the Examiner cited two different passages as an alleged disclosure in Haudry of motor control circuitry. In contrast to the Examiner's interpretation, the first passage (col. 1, ll. 24-33) discloses that the communication module 3 communicates with the protection and control module 2. *See Haudry, col. 1, lines 24-28; see also col. 3, lines 16-20.* The protection and control module 2 in turn monitors the current through the switch and signals to a control part in the

housing 1 when a fault is detected. *See* Haudry, col. 2, lines 40-50. Despite the Examiner's suggestion to the contrary, the Haudry reference does not disclose that either module 2 or 3 controls a motor or a machine as recited in the present independent claims. Note that for at least this reason, Applicant also traverses the Examiner's use of Official Notice, and requests that the Examiner demonstrate by objective evidence, consistent with MPEP 2133.04 that (1) the art proves that the circuitry of Haudry could be replaced with motor control circuitry; (2) that such circuitry would be electrically connected downstream of protection circuitry; and (3) that all such circuitry would be placed on a modular machine-mounted base.

The second passage cited by the Examiner (col. 4, ll. 7-16) describes an embodiment of the communication module 3 in which the module 3 may "control a display" or "provide information about the motor load to a controller." Haudry, col. 4, lines 11-15. Again, this passage does not disclose motor/machine control as the Examiner asserted. On the contrary, this passage states that information may be sent from the communication module 3 to a controller, thus indicating that the module itself is not a machine controller.

In addition, the Examiner did not suggest that these deficiencies would be obvious in view of the Haudry reference. Rather, the Examiner argued that the Haudry reference explicitly discloses these elements of the claimed invention and merely lacks the disclosure that the housing 1 is mounted on a motor. Office Action, page 12. For at least these reasons, the Examiner did not set forth a *prima facie* case of obviousness over Haudry with respect to independent claims 1, 16, 31, 34, 51, or 79 or their dependent claims.

In rejecting claim 79, the Examiner asserted that Haudry allegedly discloses a controller for a machine system comprising a modular control unit [Fig. 1, comprising modules 2 and 3], comprising control circuitry configured to directly control a machine; a first connector [Fig. 1, 26A,B; 24,25; alternatively 23] configured to couple with an on-machine motor protection base; and a second connector [Fig. 1, 19A,B; 24,25, alternatively 23] configured to couple with the machine to enable control of the machine by the modular control unit, but fails to disclose that

module 2 and module 3 can be one module. The Examiner asserted that the deficiency is remedied by the conventional knowledge in the art at the time of the invention, and that one of ordinary skill in the art would know that combining the two modules into one would yield benefits inherent to integration. Applicant asserts that despite the assertions made by the Examiner, Haudry fails to disclose all of the recitations within independent claim 79 as presently amended. Further, Applicant stresses that the conventional knowledge in the art at the time of the invention fails to remedy these deficiencies. Here again, Applicant traverses the use of Official Notice on the same grounds set forth above.

For at least these reasons, the Examiner did not establish a *prima facie* case of obviousness over Haudry with respect to independent claims 1, 16, 31, 34, 51, or 79; or any of their dependent claims. In view of the cited deficiencies of the rejections under 35 U.S.C. § 103 in view of Haudry and in light of the present amendments, Applicant respectfully requests removal of the rejections of independent claims 1, 16, 31, 34, 51, and 79 and their dependent claims, under 35 U.S.C. § 103, as these claims are clearly not obvious in view of Haudry.

**Rejection of claims 10-11, 22-23, 29 and 57-58 as unpatentable over Haudry in view of Hollenbeck**

With respect to claims 10, 22, 29, and 58, the Examiner asserted that Haudry teaches the controller of the independent claims but does not teach a soft start controller. The Examiner asserted that the hypothetical combination of Haudry with Hollenbeck remedies this deficiency.

Applicant asserts that the claims in question are allowable based at least on their dependency from allowable base claims. Applicant stresses that Haudry fails to disclose and/or render obvious all of the recitations within the independent claims, for at least the reasons stated above. Hollenbeck fails to remedy these deficiencies.



Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 10-11, 22-23, 29 and 57-58 under 35 U.S.C. § 103 based on the hypothetical combination of Haudry and Hollenbeck.

**Rejection of claims 80-82 as unpatentable over Haudry in view of Knox**

In rejecting claims 80-82, the Examiner asserted that Haudry discloses the second connector as recited in claim 79, but fails to disclose an external cable disposed on an external surface of the modular control unit. The Examiner asserted that the hypothetical combination of Haudry with Knox remedies this deficiency.

However, Applicant respectfully reminds the Examiner that a *prima facie* case of obviousness requires that all claim features must be taught or suggested by the art. Applicant stresses, in view of the comments above, that both Knox and Haudry fail to disclose features consistent with the independent claim 79. As such, claims 80-82, which depend from claim 79 are believed to be allowable.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection to claims 80-82 under 35 U.S.C. § 103 based on the hypothetical combination of Haudry and Knox.

**Conclusion**

Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: December 1, 2009

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